

REMARKS

Reconsideration of the above-identified application in view of the above amendments and following remarks is respectfully requested. Claims 1-16 have been cancelled. New claims 17-30 have been added.

New Claims 17-27 and 28-30

The present application is a continuation-in-part of U.S. Application No. 09/428,839, filed October 28, 1999 (the "parent application"). In the parent application, claims 1-3, 6-10 and 12-14 stand allowed, however, Applicants have not yet paid the applicable issue and publication fees, which are due October 1, 2003. Rather than paying such fees and having claims 1-3, 6-10 and 12-14 issue in the parent application, Applicants would like these same claims to issue in the present application, along with additional dependent claims directed to further specific embodiments disclosed therein.

Accordingly, Applicants have added (i) new claims 17-27, which are identical to allowed claims 1-3, 6-10 and 12-14 in the parent application, and (ii) new dependent claims 28-30, directed to further specific embodiments disclosed in the present application (*e.g.*, a sample analysis instrument wherein the first light source and the first photodetector of the flow cytometric measuring apparatus are positioned to be in the same plane as a stream of particles flowing through the first analysis region). Support for new claims 28-30 may be found in Figures 15A and 15B, and the corresponding description of such Figures at page 20, lines 3-13.

If new claims 17-30 are allowed in the present application, Applicants will allow the parent application to go abandoned by failure to pay the issue fee.

Objection to the Specification

The specification is objected to as failing to provide proper antecedent basis for claim 16 which recites "the instrument of claim 1 which is disposable." Applicants respectfully submit that this objection has been obviated by the above amendments. More specifically, (i) Applicants have cancelled claim 16, and (ii) new claim 25, which is similar to cancelled claim 16, correctly recites "the instrument of claim 17 wherein said cartridge is disposable." Accordingly, Applicants request that this ground of rejection be withdrawn.

Objection to the Claims

The language "having a first analysis regions" in claim 1 and the numbering of claims 3-16 are objected to. Applicants submit that, in light of the above amendments, these objections are no longer applicable.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to the language "said apparatus." As set forth above, claims 1-14 have been cancelled. Furthermore, new claims 17-30 explicitly refer to "a flow cytometric measuring apparatus," "an absorption measuring apparatus," "said flow cytometric measuring apparatus" and "said absorption measuring apparatus." Accordingly, Applicants submit that the pending claims satisfy the second paragraph requirements of §112 and request that this ground of rejection be withdrawn.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-7, 9-11 and 13-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Miyazaki et al. (U.S. Patent No. 5,370,842). Applicants respectfully submit that in light of the above amendments, this ground of rejection has been overcome.

As discussed in Applicants' Amendment, filed June 16, 2003 in the parent application, new claim 17 (which corresponds to claim 1 of the parent application) is directed to a sample instrument, for use with a fluidic cartridge having two analysis regions, comprising both a first and a second analysis apparatus; namely, "a flow cytometric measuring apparatus positioned to be optically coupled with said first analysis region, *said flow cytometric measuring apparatus comprising a first light source, a first photodetector and a second photodetector*" and "an absorption measuring apparatus positioned to be optically coupled with said second analysis region, *said absorption measuring apparatus comprising a second light source and a third photodetector.*" (Emphasis added.)

As stated by the Examiner in both the present and the parent applications, Miyazaki teaches a sample measuring system including a cartridge holder and a disposable flow

cytometric cartridge having two different analysis regions. In the first analysis region, the cartridge comprises two photodetectors 59, 61 and, in the second analysis region, the cartridge comprises an electrical measuring apparatus; namely, two electrodes 63, 64 for measuring the electrical impedance of particles in the sample. Furthermore, apart from the cartridge, Miyazaki discloses two light sources 65, 67 for directing light to photodetectors 59, 61, respectively, in the first analysis region.

In light of the foregoing, and as noted in the parent application, Miyazaki does not disclose a system comprising both a flow cytometric measuring apparatus and an absorption measuring apparatus as claimed by the present invention. More specifically, the following elements of the sample instrument of pending claim 17 are absent from the system disclosed by Miyazaki.

1. The second analysis region of Miyazaki comprises an electrical measuring apparatus comprising two electrodes, rather than an absorption measuring apparatus comprising a light source and a photodetector as recited in pending claim 17.

2. In the system disclosed by Miyazaki, certain elements of both measuring apparatus (*i.e.*, photodetectors 59, 61 and electrodes 63, 64) are part of the fluidic cartridge, rather than the sample measuring system. Only the light sources 65, 67 are disclosed as being separate from the cartridge. To the contrary, in the sample instrument of pending claim 17, all elements of both measuring apparatus - that is, the first light source, first photodetector and second photodetector of the flow cytometric apparatus and the second light source and third photodetector of the absorption measuring apparatus - are part of the sample instrument and are separate from the cartridge. In this way, the self-contained sample instrument of pending claim 17 may be used with relatively simple and inexpensive disposable cartridges, whereas, the system disclosed by Miyazaki requires the use of more complex cartridges containing a number of detecting elements, such as photodetectors.

In the Notice of Allowance, mailed July 1, 2003 in the parent application, the Examiner agreed that Miyazaki does not disclose every element of pending claim 1 and found claims 1-3, 6-10 and 12-14 to be allowable. Accordingly, in view of the foregoing, Applicants respectfully request that this ground of rejection also be withdrawn as applied to new claims 17-30.

Rejection Under 35 U.S.C. § 102(e)

Additionally, claims 1-10 and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Altendorf et al. (U.S. Patent No. 5,726,751). Applicants respectfully submit that in light of the above amendments, this ground of rejection has been overcome. As stated by the Examiner, Altendorf teaches an optical flow cytometer instrument including a cartridge holder, for engaging a cartridge having a first analysis region, and a flow cytometric measuring device optically coupled to the first analysis region. However, Altendorf does not disclose an instrument also comprising an absorption measuring apparatus as claimed by the present invention. Furthermore, there is no teaching or suggestion in Altendorf to modify the instrument disclosed therein to include such an absorption measuring apparatus. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn as applied to new claims 17-30.

Rejection Under 35 U.S.C. § 103(a)

Claim 12, which is similar to new claim 24, stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyazaki et al. (U.S. Patent No. 5,370,842). This rejection is based on the Examiner's conclusion that Miyazaki discloses the sample instrument of claim 1. However, as set forth above, Miyazaki does not disclose the sample instrument of new claim 17, from which new claim 24 is dependent. Furthermore, Miyazaki contains no teaching or suggestion to modify the sample measuring system disclosed therein in order to produce the claimed sample instrument of the present invention. Accordingly, Applicants request that this ground of rejection be withdrawn.

Rejection for Double Patenting

Claims 1-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-10, 12 of the parent application (*i.e.*, U.S. Application No. 09/428,839). As set forth above, if new claims 17-27 and 28-30 are allowed in the present application, Applicants will allow the parent application to go abandoned.

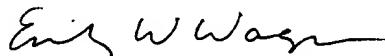
Application No. 09/723,825
Reply to Office Action mailed February 4, 2003

In view of the above amendments and remarks, allowance of claims 17-30 is respectfully requested. A good faith effort has been made to place this application in condition for allowance. However, should any further issue require attention prior to allowance, the Examiner is requested to contact the undersigned at (206) 622-4900 to resolve the same. Furthermore, the Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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